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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,704	09/16/1999	GERALD Craig ALTOMARE	6925-196	9091

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EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 04/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/397704

Applicant(s)

Attorney

Examiner

Blas, J

Group Art Unit

2164

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/16/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-40 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-40 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 2164

### DETAILED ACTION

1. Claims 1-40 have been examined.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-40 are rejected under 35 USC 103(a) as unpatentable over Graff(US Pat. No: 5,802,501) in view of Luskin(US Pat. No: 5,812,987).
4. As per claims 1,11,16,25,27-28 Graff teaches a computer-based method for administering financial instruments comprising the steps of establishing a trust(col 2 lines 63-66)(col 36 lines 41-66) with trust units(col 5 line 5) each unit comprising a bond having a maturity date(col 4 lines 1-31) and one or more shares of a security(col 4 line 47-col 5 line 8)(col 30 lines 14-24) where the total number of shares is defined as a share ratio and a unit par price is determined based on the values of the underlying bond and the shares of the security at a predetermined time(Abstract)(col 2 line 60-col 3 line 17)(Fig 1)(Fig 6)(col 11 lines 15-18)(col 24 line 60-col 26 line 56).Graff fails to teach periodically computing the price of the trust units based on the share ratio for the period and the current values of the underlying bond and the shares of the security. Luskin teaches this(Abstract)(Fig 6/808/712)(Fig 8/809/807/811/813)(col 2 line 29-63)(col 3 line 39-col 4 line 67) as well as comparing the computed price of the unit to a predetermined price and making a

Art Unit: 2164

distribution to unit holders based on the comparison(col 5 lines 1-15)(col 6 line 5-16)(col 8 lines 7-19)(col 9 line 37-col 12 line 10).It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

5. As per claims 2,3,6,8,(14)((22))(((19))),((((35))))((((37))))((((38)))) Graff teaches making a final payment on the maturity date of the bond(Fig 5A)(Fig 5B)(Fig 5C)(Fig 5D). Graff however fails to teach a method according to claims 1,(11),((21)),(((16))),((((28))), (((((27))))), ((((((28)))))) respectively wherein some of the distribution is made of shares of the security as well as the distribution comprising distributing the excess of the current price and the predetermined price and reinvesting distributions made to unit holders into new units(Fig 6/904) Luskin teaches this (col 5 lines 1-15)(col 6 lines 5-16)(Fig 6/808).It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

6. As per claims 4,12,20,33 Graff fails to teach according to the method of claims 3,11,19,28 respectively comprising the step of converting the excess difference into an excess number of shares based on the current share price. Luskin teaches this(col 2 lines 38-47)(col 3 lines 2-5)(col

Art Unit: 2164

3 line 57-60)(col 5 lines 1-31). It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

7. As per claims 5,13,21,34 Graff fails to teach the method of claims 4,12,20,33 respectively adjusting the share ratio of the trust units to reflect the distributed number of shares. Luskin teaches this(Abstract)(Fig 6/808/712)(Fig 8/809/807/811/813)(col 2 line 29-63)(col 3 line 39-col 4 line 67). It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

8. As per claims 7,15,36 Graff fails to teach the method of claims 5,13,35 respectively comprising the step of reinvesting distributions made to unitholders. Luskin teaches this(col 2 lines 38-47)(col 3 lines 2-5)(col 3 line 57-60)(col 5 lines 1-31). It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

Art Unit: 2164

9. As per claim 9,18 Graff teaches a computer software product for implementing the steps of the method of claim 1 on a computer(Abstract)(col 5 lines 11-23)(col 5 line 65-col 6 line 23).

10. As per claims 10,39 Graff fails to teach a computer software product of claims 9,28 comprising an Excel spreadsheet program. Luskin teaches this (col 5 line 66-col 6 line 4).It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

11. As per claim 17 Graff teaches the system of claim 16 wherein the database is an access database(col 11 lines 18-58)(Fig 2).

12. As per claim 26 Graff fails to teach the method of claim 25 wherein some of the distribution to unit holders is made in shares of the security. Luskin teaches this (col 5 lines 1-15)(col 6 line 5-16)(col 8 lines 7-19)(col 9 line 37-col 12 line 10).It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

13. As per claim 29 Graff fails to teach specifically that the security selected is among the large cap stocks. Luskin teaches this(col 2 lines 32-34)(col 4 lines 43-49)(col 6 lines 13-18)(col 8 lines

Art Unit: 2164

8-61)(Table 1).It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

14. As per claim 30 Graff fails to teach the method of claim 28 wherein the long-term bond issue is a US Treasury strip. Luskin teaches this(col 2 lines 32-34)(col 2 lines 62-63)(col 4 lines 43-49)(col 6 lines 13-18)(col 8 lines 8-61)(Table 1)..It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

15. As per claim 31 Graff fails to teach the method of claim 30 wherein the term for the bond is between 20-30 years. Luskin teaches this(col 2 lines 32-34)(col 4 lines 43-49)(col 6 lines 13-18)(col 8 lines 8-61)(Table 1).It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

Art Unit: 2164

16. As per claim 32 Graff fails to teach the method of claim 28 wherein the period for determining the value of the trust units is quarterly. Luskin teaches this Luskin teaches this(Abstract)(Fig 6/808/712)(Fig 8/809/807/811/813)(col 2 line 29-63)(col 3 line 39-col 4 line 67).Furthermore Luskin teaches this method for a company 401K retirement which is reviewed quarterly(col 2 lines 50-53). It would have been obvious to one skilled in the art at the time of the invention to combine Graff in view of Luskin to teach the above. The motivation to combine is to teach a method for one to make appropriate investments to select investments that reflect risk-return trade-offs and to revise these investments through time in response to changing market conditions as enunciated by Luskin(col 2 lines 18-25).

17. As per claim 40 Graff teaches the system of claim 39 further comprising information about the trust units and customer accounts in a database accessible by the account administrator(Fig 3)(Fig 2/32)(col 16 lines 26-39).

### *Conclusion*

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Tull teaches a data processing system for financial debt instruments

-Graff(US 6,192,347) teaches further a system for computing to support decomposing property into separately valued components

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Art Unit: 2164

19. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703)-308-6296 or 6306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3900.

GRA 

April 15, 2002